

## **II. REMARKS/ARGUMENTS**

### **A. Status of Claims**

Claims 38 and 47-52 are currently pending. Claims 1-37 and 39-46 were previously cancelled. No amendments have been made to the claims.

### **B. Rejection under 35 U.S.C. 103 (a) over Baker et al. and Tanaka et al.**

In the Office Action, the Examiner rejected claims 38, 47-48, 50-52 under 35 U.S.C. 103 (a) over US 4,569,937 (hereinafter "the Baker reference") and Tanaka et al. *Arzneimittel-Forschung* (1992) Vol. 42 (7) pages 935-44 (hereinafter "the Tanaka reference").

Initially, Applicants believe a review of the present invention is in order. Independent claim 1 is directed to "[a] method of effectively treating pain in humans, comprising orally administering to a human patient an oral dosage form comprising analgesic compounds consisting essentially of (i) N-[3-(formylamino)-4-oxo-6-phenoxy-4H-1-benzopyran-7-yl] methanesulfonamide and/or at least one pharmaceutically acceptable salt thereof; and (ii) oxycodone and/or at least one pharmaceutically acceptable salt thereof." (Emphasis Added).

As recited in the claim, the present invention is directed to a method of treatment utilizing analgesic compounds consisting essentially of two particular agents (i.e., N-[3-(formylamino)-4-oxo-6-phenoxy-4H-1-benzopyran-7-yl] methanesulfonamide and oxycodone, or their respective salts). Thus, the present claims exclude any other analgesic compound than those recited.

In making the present rejection, the Examiner states that "Baker et al. teach pharmaceutical compositions ... comprising a combination of: a. a narcotic analgesic ... and b. ibuprofen (a non-steroidal anti-inflammatory drug or NSAID)." Applicants respectfully traverse the rejection as the Examiner's reliance on the Baker reference is unfounded.

The purported invention of the Baker reference is directed to pharmaceutical compositions of narcotic analgesics and ibuprofen which "... exhibit unexpectedly enhanced analgesic activity ..." (See Abstract). The Baker reference is limited to combinations wherein the NSAID is ibuprofen and does not teach or suggest that the purported "unexpectedly enhanced analgesic activity" would occur with an NSAID which is different than ibuprofen. Accordingly, the Baker reference teaches narcotic analgesics in combination with ibuprofen, and not in combination with the broad class of NSAIDS as asserted by the Examiner. Columns 1 -2, cited to by the Examiner, only mention the acronym 'NSAID' twice at column 1, lines 21 and 23, and that is in a discussion of prior art; it is not a teaching of the Baker reference.

Based on Applicants review of the Baker reference, it appears that Baker et al. rejected all NSAIDs in their invention *except* ibuprofen. The purported invention and teachings of Baker et al. are limited to the combination of a narcotic analgesic and ibuprofen. The Examiner is respectfully directed to, for example, column 1, lines 6 - 9 of Baker et al. which states as follows:

*This invention relates to pharmaceutical compositions of narcotic analgesics and ibuprofen having analgesic activity in mammals, and to methods of use of the compositions to alleviate pain in mammals.*

(Emphasis Added)

The Examiner is also directed to, for example, column 2, lines 11-15 of Baker et al. which states as follows:

*According to the present invention there is provided a pharmaceutical composition comprising a combination of (a) a narcotic analgesic, or a pharmaceutically acceptable salt thereof, and (b) ibuprofen, or a pharmaceutically suitable salt thereof,...*

(Emphasis Added)

As set forth above, the Baker reference is specifically directed to ibuprofen in combination with opioid analgesics. The Baker reference ignores all other NSAID's, except in a discussion of the prior art from which Baker et al. depart. Accordingly, Applicants respectfully submit that modifying the formulation of the Baker reference in view of the Tanaka reference as

proposed by the Examiner by substituting ibuprofen with N-[3-(formylamino)-4-oxo-6-phenoxy-4H-1-benzopyran-7-yl] methanesulfonamide would result in a dosage form which is not directed to the principle of operation described in Baker et al. (i.e., the purported synergism of narcotic analgesics and ibuprofen). The Examiner is reminded that "[i]f the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious." See MPEP 8<sup>th</sup> edition, Revision 2, p.2100-132.

It is respectfully submitted that the Baker reference teaches away from substituting ibuprofen with another NSAID (e.g., N-[3-(formylamino)-4-oxo-6-phenoxy-4H-1-benzopyran-7-yl] methanesulfonamide), because of the unexpected synergy that it purports for the combination of ibuprofen with a narcotic analgesic. Accordingly, due to this purported synergy, one skilled in the art would be discouraged to combine the Baker reference with the Tanaka reference in order to select an NSAID different than ibuprofen (i.e., N-[3-(formylamino)-4-oxo-6-phenoxy-4H-1-benzopyran-7-yl] methanesulfonamide) to combine with oxycodone. The Examiner is reminded that "[a] prior art reference may be considered to teach away when 'a person of ordinary skill, upon reading the reference would be discouraged from the path set out in the reference, or would be led in a direction divergent from the path that was taken by the applicant.'" See *Monarch Knitting Machinery Corp. v. Sulzer Morat GmbH*, 45 USPQ2d 1977, 1984 (Fed. Cir. 1998).

Furthermore, Applicants again submit that the Examiner is improperly picking and choosing the N-[3-(formylamino)-4-oxo-6-phenoxy-4H-1-benzopyran-7-yl] methanesulfonamide of the Tanaka reference with the oxycodone of Baker et al. to recreate the claims of the present application. One "...cannot pick and choose among the individual elements of assorted prior art references to recreate the claimed invention." *SmithKline Diagnostics, Inc. v. Helena Laboratories Corporation*, 859 F.2d 878, 887 (Fed. Cir. 1988).

In the Office Action, the Examiner stated that "Applicant's interpretation of the Baker patent reference fails to consider the Baker teaching as a whole to one of ordinary skill in the

art". On the contrary, Applicants submit that, as a whole, the Baker reference would steer one of ordinary skill in the art away from combining the Baker reference with the Tanaka reference to select an NSAID different than ibuprofen (i.e., N-[3-(formylamino)-4-oxo-6-phenoxy-4H-1-benzopyran-7-yl] methanesulfonamide) to combine with oxycodone, for the reasons argued above.

In view of the arguments presented, it is respectfully requested that the 35 U.S.C. 103(a) rejection over Baker et al. and Tanaka et al. be removed.

**C. Rejection under 35 U.S.C. 103 (a) over Baker et al. and Tanaka et al. in view of Oshlack et al. (US 5,472,712) or Oshlack et al. (US 6,294,195)**

In the Office Action, the Examiner further rejected claim 49 under U.S.C. 103 (a) over Baker et al. and Tanaka et al. in view of US 5,472,712 (Oshlack et al.) and US 6,294,195 (Oshlack et al.)

This rejection is traversed. It is respectfully submitted that the Oshlack references do not cure the deficiencies of the Baker reference in view of the Tanaka reference as set forth above.

Accordingly, it is respectfully requested that the 35 U.S.C. 103(a) rejection over Baker et al., Tanaka et al. and Oshlack et al. be removed.



**III. CONCLUSION**

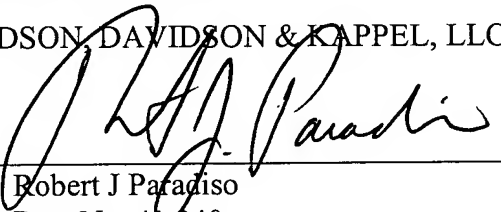
In view of the foregoing, it is believed that the application is now in condition for allowance, and applicants respectfully request such action.

The Examiner is respectfully requested to contact the undersigned at the telephone number provided below in the event that a telephonic interview will advance the prosecution of the application.

Respectfully submitted,

DAVIDSON, DAVIDSON & KAPPEL, LLC

By: \_\_\_\_\_

  
Robert J Paradiso  
Reg. No. 41,240

DAVIDSON, DAVIDSON & KAPPEL, LLC  
Patents, Trademarks and Copyrights  
485 Seventh Avenue, 14<sup>th</sup> Floor  
New York, New York 10018  
(212) 736-1940